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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79145119
Applicant	Powerful Vision Limited
Applied for Mark	DIAMOND X COLLECTION
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Serial No.:	79145119
Applicant:	Powerful Vision LLC
Filed:	January 23, 2014
Mark:	DIAMOND X COLLECTION

APPLICANT'S BRIEF ON APPEAL

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I. INTRODUCTION

This is an appeal from the Office Action dated October 9, 2014, in the above-identified application, issuing a final refusal of registration for the Applicant's, Powerful Visions LLC ("Applicant") mark DIAMOND X COLLECTION for "Mirrors; Mirrored bathroom furniture made of plastic, mild steel, stainless steel and aluminum; mirrored bathroom cabinets made of plastic, mild steel, stainless steel and aluminum; mirrored cabinets made of plastic, mild steel, stainless steel and aluminum; mirrors enhanced by electric lights," in International Class 20 (the "Mark").

The Patent and Trademark Office ("PTO") refused registration under Section 2(d) of the Lanham Act, maintaining that the Mark so resembles a registered mark that is likely to cause confusion. As explained below, Applicant submits that this refusal should be reversed because 1) the marks are not similar, 2) the trade channels differ, and 3) no disclaimer is necessary.

II. PROSECUTION HISTORY

On January 23, 2014, Applicant filed a trademark application for the standard character mark DIAMOND X COLLECTION (Serial No. 79145119) in connection with "Furniture; mirrors; furniture made of wood, plastic, mild steel, stainless steel and aluminium which are not included in other classes; cabinets; bathroom cabinets; mirrored cabinets; mirrors enhanced by electric lights." In an Office Action dated April 29, 2014 the PTO refused registration under Section 2(d) of the Lanham Act, claiming that the Mark was likely to be confused with Registration No. 1231958 ("958 Registration") for DIAMOND because of the similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. Office Action, p. 2 (April 29, 2014) (hereinafter "Initial Refusal"). The

PTO suggested revisions to the identification of goods and required Applicant to disclaim both "DIAMOND" and "COLLECTION" apart from the mark. Initial Refusal, p. 4.

Applicant responded on September 18, 2014, to explain that the Mark is not similar to the '958 Registration and that the channels of trade differ. Applicant also adopted the PTO's suggested revisions and amended its description of goods to read:

Mirrors; Mirrored bathroom furniture made of plastic, mild steel, stainless steel and aluminum; mirrored bathroom cabinets made of plastic, mild steel, stainless steel and aluminum; mirrored cabinets made of plastic, mild steel, stainless steel and aluminum; mirrors enhanced by electric lights.

Applicant further explained that the require disclaimer was unnecessary.

The PTO refused registration in a final Office Action dated October 9, 2014, (hereinafter "Final Action") in which it made final its refusal to register the Mark under Section 2(d) of the Lanham Act. Final Action, p. 3. The PTO again reiterated that the Mark was confusingly similar to the '958 Registration because of the similarities of the marks and the goods. Final Action, pp. 4-6. The PTO also made its disclaimer requirement final. Id. at p. 6.

Applicant responded by concurrently appealing the refusal of registration and submitting a request that the PTO reconsider the refusal on April 9, 2015. On April 30, 2015 the PTO declined to reconsider its position. Reconsideration Letter, p. 1. On May 6, 2015 the appeal of the PTO's refusal was resumed. Filed concurrently with this brief is Applicant's Motion to Accept Filing of Applicant's Appeal Brief.

III. ARGUMENT

A. Differences Between Applicant's Mark and Registrant's Mark Support Registration

The PTO has refused registration of the Mark under Section 2(d) on the basis that Mark is confusingly similar the '958 Registration because both marks contain the "DIAMOND" word element. Final Action, p. 4.

Applicant's DIAMOND X COLLECTION mark is not similar to the '958 Registration. Applicant's use of the additional matter "X COLLECTION" differentiates and distinguishes its mark from Registrant's mark. The only similarity the two marks share is the parties' use of the term "DIAMOND." In all other respects, Applicant's mark neither looks nor sounds similar to Registrant's mark. The mere fact that both marks incorporate a form of the common term does not render the marks sufficiently similar to establish likelihood of confusion. See e.g., Freedom Savings & Loan Ass'n v. Way, 757 F.2d 1176, 1183 (11th Cir.1985) (holding "FREEDOM REALTY" and "FREEDOM SAVINGS AND LOAN" are not sufficiently similar); Sun Banks of Florida, Inc. v. Sun Federal Sav. And Loan Ass'n, 651 F.2d 311, 316 (5th Cir.1981) ("SUN FEDERAL AND SAVINGS LOAN ASSOCIATION" not confusingly similar to "SUN BANKS"); Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 260 (5th Cir.1980) ("DOMINO'S PIZZA" not similar to "DOMINO SUGAR"); Bell Laboratories, Inc. v. Colonial Prods., Inc., 644 F.Supp. 542, 547 (S.D.Fla.1986) ("FINAL FLIP" and "FLIP" marks for same product are "ultimately different and different sounding"). Moreover, likelihood of confusion cannot be predicated on dissection of a mark. In re National Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985) citing Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273-74 (CCPA 1974), and Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007, 212 U.S.P.Q. 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). Thus, Applicant's use of the phrase DIAMOND X COLLECTION creates a distinct effect on the eye, on the ear, and on the mind from Registrant's single word mark, DIAMOND.

B. Differences Between Applicant's Trade Channel and the Registrant's Trade Channel Supports Registration

The PTO also refused registration of the Mark on the grounds that goods covered by the application are confusingly similar to the '958 Registration for "wooden cabinets." Final Action, p. 5.

Applicant's amended goods/services are not related to those in the cited registration and travel in distinct channels of trade. The '958 Registration is for "wooden cabinets." The '958 Registration describes goods narrowly, and incorporates limitation as to their nature, type, channels of trade, or class of purchasers. Applicant's goods, as amended, consist of mirrors, mirrored bathroom furniture and bathroom cabinets made of plastic, mild steel, and aluminum. Thus, Registrant's and Applicant's trade channel differs. "[A] restriction in the channels of trade will tend to avoid likelihood of confusion," In re Shoe Works, Inc., 6 U.S.P.Q.2d 1890 (T.T.A.B. 1988) (no likely confusion was found between PALM BAY for womens' shoes and the cited PALM BAY for shorts and pants where applicant amended the description of goods to "women's shoes sold solely through applicant's retail shoe store outlets"). In determining the registrability of a mark, the Office is to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration(s). See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 U.S.P.Q.2d 1783 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 U.S.P.Q.2d 1813 (Fed. Cir. 1987). Applicant's amended goods are thus distinguishable from the '958 Registration.

If the Board finds that Applicant's goods are not distinguishable from the '958 Registration, Applicant hereby respectfully requests that the identification of goods in the application be further amended as follows:

Mirrors; Mirrored bathroom furniture made of plastic, mild steel, stainless steel and aluminum; ~~mirrored bathroom cabinets made of plastic, mild steel, stainless~~

~~steel and aluminum; mirrored cabinets made of plastic, mild steel, stainless steel and aluminum; mirrors enhanced by electric lights.~~

For the reasons stated above, such an amendment would eliminate any possible confusion between the Mark and the '958 Registration.

C. Disclaimer is Unnecessary

The PTO also required to the Applicant to disclaim the wording "DIAMOND" and "COLLECTION" on the grounds that it merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of Applicant's goods. Final Action, p. 6.

Applicant's DIAMOND X COLLECTION mark is a unitary mark and disclaimer should not be required. The mark DIAMOND X COLLECTION as a whole has a suggestive significance which is distinctly different from the merely descriptive significance of the terms DIAMOND and COLLECTION. When the registrable and unregistrable elements of a composite mark are so integrated or merged together that they cannot be regarded as separable units, no disclaimer should be required. See In re EBS Data Processing, Inc., 212 U.S.P.Q. 964 (TTAB 1981); see also In re Kraft, Inc., 218 U.S.P.Q. 571, 1983 WL 51972 (T.T.A.B. 1983) (the Board reversed the Trademark Attorney's requirement of a disclaimer of LIGHT from LIGHT N' LIVELY for low calorie mayonnaise on the ground that LIGHT N' LIVELY was a unitary phrase); "X" Laboratories, Inc. v. Odorite Sanitation Service of Baltimore, Inc., 106 U.S.P.Q. 327, 1955 WL 6457 (Comm'r Pat. & Trademarks 1955) (no disclaimer required of "TIRE" in the unitary mark TIRE-X for a tire cleaner). Thus, no disclaimer should be required of the terms "DIAMOND" and "COLLECTION" in the unitary mark DIAMOND X COLLECTION.

IV. CONCLUSION

For the foregoing reasons, Applicant submits that the Mark is not likely to cause confusion and that the refusal to register under Section 2(d) should be reversed.

Dated this 14th day of July, 2015.

Respectfully submitted,



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